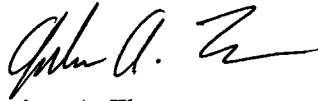


PRE-APPEAL BRIEF REQUEST FOR REVIEW (filed with the Notice of Appeal)		Docket Number 042933/269783
Application Number 10/715,161	Filed November 17, 2003	
First Named Inventor: Olof Schybergson et al.		
Art Unit 2624	Examiner Alex Kok Soon Liew	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>Respectfully submitted,</p> <p> Jonathan A. Thomas Registration No. 62,200</p> <p>Date <u>9/7/10</u></p> <p>Customer No. 00826 ALSTON & BIRD LLP Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Charlotte Office (704) 444-1000 Fax Charlotte Office (704) 444-1111</p> <p>ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON September 7, 2010. LEGAL02/32156081v1</p>		

ATTACHMENT

Reasons for Requesting Pre-Appeal Brief Request for Review

The Office Action has rejected claims 1-4, 6-8, 13-17, 28, and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,996,782 to Parker et al. (hereinafter “Parker”) in view of U.S. Patent Application Publication No. 2001-0056434 to Kaplan et al. (hereinafter “Kaplan”). Claims 9 and 10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Kaplan and in further view of U.S. Patent No. 5,732,184 to Chao et al. (hereinafter “Chao”). Claims 11, 12, and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker in view of Kaplan and in further view of U.S. Patent No. 4,589,140 to Bishop et al. (hereinafter “Bishop”).

Independent Claim 1 is directed to an application that includes a computer readable storage medium having computer-readable program instructions embodied therein. The computer-readable program instructions include first instructions for generating a media view that segments time into time units and second instructions for generating a topographic view that graphically represents media file quantity in relation to the time units presented in the media view. Independent Claim 1 further recites that the second instructions generate the topographic view “so as to individually represent media file quantity for each of a plurality of different media file types[.]” In addition, the second instructions “concurrently display the individual representations of the media file quantity for each of the plurality of different media file types in relation to the same time units.” For example, Figures 2-4 depict line graphs of five different media file types indicating the quantity of each different media file type over the course of time.

The Final Office Action recites in the Response to Applicant’s Arguments that “[t]he examiner agrees with the applicant, where the histogram does not provide any indication of the type of digital objects that are present in any particular time period. However, in an updated search shows that Kaplan (US pub no 2001/0056434) discloses providing indication of the type of digital object, such as an audio file, image file or a video file (*see figure 7, elements 36 and 48*).” Applicant respectfully disagrees and asserts that the combination of Parker and Kaplan is improper. Further, even if the teachings of Parker were combined with those of Kaplan, the teachings do not render obvious the claimed invention.

The Combination of Parker and Kaplan is Improper

The Office Action recites on page 5 that “Parker is silent providing indication of different types of digital objects, such as an audio file, image file or a video file in a display window. However, it is well known to use a plurality of other multimedia contents such as audio files or video files to record current or social events.” The Office Action then cites Kaplan as disclosing “provid[ing] indication of different type of digital objects, such as an audio file, image file or a video file (*see figure 7, elements 36 and 48*) in a display window. However, the Office Action does not provide a reason for performing the modification. The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1731 (2007), stated that:

Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

See id. at 1396 (emphasis added).

The “reason” provided in the Office Action is a mere conclusory statement that “it would have been obvious to one having ordinary skill in the art at the time of the invention was made to include to provide indication of different type of digital objects to allow user or operator to easily differential between the types of media files in order to reduce amount of time searching or retrieving multimedia files.” As such, the assertion of the final Office Action regarding motivation to combine the references is at best a broad conclusory statement which, standing alone, is not an explicit statement that provides an apparent reason for combining the cited references.

Furthermore, one skilled in the art would not have been motivated to combine Parker and Kaplan, except as a result of the impermissible application of hindsight. In fact, the Court of Appeals for the Federal Circuit has stated that “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure of a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although the evidence of a suggestion, teaching or motivation to combine the references commonly comes from the prior art references themselves, the suggestion, teaching or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. *Id.* In any event, the showing

must be clear and particular and “[b]road conclusory statements regarding the teaching effort of multiple references, standing alone, are not ‘evidence.’” *Id.*

As stated in MPEP § 2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). Thus the combination of Parker and Kaplan is improper and the rejections that rely upon the combination (specifically Claims 1-4, 6-17, and 28-34) should be withdrawn.

The Combination of Parker and Kaplan Does Not Teach the Claimed Invention

Claim 1 recites *inter alia* “wherein the second instructions are configured to generate the topographic view so as to individually represent media file quantity for each of a plurality of different media file types[.]” As noted above, the Office Action admits that Parker fails to teach or suggest this feature. In the amendment filed March 5, 2010, the Applicant stated that “the histogram does not provide any indication of the type of digital objects that are present in any particular time period. Instead, the histogram is a bar graph illustrating the number of digital objects per time period, but not the type of video objects.” The Examiner agrees with this as stated on page 2 of the Office Action and cites Kaplan to rectify the deficiency. The Office Action cites, in particular, figure 7 of Kaplan and elements 36 and 48.

Applicant respectfully disagrees with the Office Action’s interpretation of Kaplan and points to the disclosure of Kaplan as failing to teach the features alleged by the Office Action. The Office Action states on page 2 that Kaplan “discloses providing indication of the type of digital object.” Applicant notes that teaching the “type of digital object” alone does not cure the deficiencies of Parker. Further, Kaplan does not teach grouping objects by type as alleged. Figure 7 of Kaplan merely illustrates a folder system of a typical computer. The folders shown (named “containers” in the disclosure of Kaplan) are merely buckets whose contents are unrestricted to a particular file type. Paragraph [0042] of Kaplan recites in part:

Any number of containers 48 can be set up by the user to represent various types or categories of multimedia content. Once a container 48 is designated the user then assigns it an image that will appear in the thumbnail 36 for that container 48. The image assigned to the thumbnail 36 will be used to identify the contents of the particular container 48. In one preferred embodiment of the present invention, a series of default containers 48 are set up to hold types of multimedia content for movies 56, photos 50, and songs 52. Several examples of user designated categories of multimedia content include images of space 45 and pictures of kids 58.

Thus, while Kaplan identifies that some containers may be named for “movies” or “photos,” the folder system does not restrict the contents of the containers by media type as alleged by the Office Action. Kaplan states in paragraph [0044] **“Of course, the user is free to store multimedia content file in any container 48 they wish.”** Thus, the organization of the folder system of Kaplan cannot accurately “individually represent media file quantity for each of a plurality of different media file types” as recited in each of the independent claims.

Thus, even if Kaplan and its disclosure of different containers of were combined with Parker, the resulting combination would still display a histogram illustrating the number of objects during each predetermined time period without separately indicating the number of each different type of digital object within a respective time period since this is currently what is provided by the system of the Parker for the various different types of digital objects. Thus, the combination of cited references would still fail to teach or suggest second instructions that are configured to generate the topographic view “so as to individually represent media file quantity for each of a plurality of different media file types ... [and] ... to concurrently display the individual representations of the media file quantity for each of the plurality of different media file types in relation to the same time units”, as set forth by independent Claim 1 and similarly recited in Claims 16 and 31.

For each of the foregoing reasons, independent Claims 1, 16, and 31 are not taught or suggested by the cited references, taken either individually or in combination. Thus, the rejections of independent Claims 1 and 16, as well as the claims which depend therefrom, are overcome.

The Rejections of the Dependent Claims

The dependent claims include each of the recitations of a respective independent claim and are therefore patentably distinct from the cited references, taken either individually or in combination, for at least the same reasons as described above in conjunction with the independent claims. However, several of the dependent claims include additional recitations that further patentably distinguish the claimed invention from the cited references.

In this regard, dependent Claims 3, 28 and 32 further define the media file quantity to be the storage volume of media files. The Official Action points to Parker in regards to the rejection of dependent Claim 3. However, the histogram generated by Parker does not illustrate media file

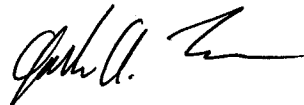
quantity as a storage volume of the media files and, instead, merely creates a histogram based on a number of media files with no accounting for the size of the various media files. See, for example, column 4, lines 19-21 of Parker which states that “[t]he length of graphical bar 80 represents the relative **number of objects** in the chosen database in a given date bin on timelines 82 and 84.” Emphasis added. Thus, dependent Claims 3, 28 and 32 are also patentably distinct from the cited references, taken either individually or in combination, for this additional reason.

Dependent Claims 11, 29 and 33 further describe the generation of a zoom mechanism that provides for a more detailed graphical representation of media files than provided by the topographic view including a graphical representation of the media files in accordance with more finely divided units than in the topographic view with both at least a portion of the topographic view and the more detailed graphical representation of the media files being concurrently displayed. See, for example, Figure 5 of the present application which illustrates a more detailed graphical representation 400 overlayed upon the topographic view. The Office Action admits that neither Parker nor Kaplan, alone or in combination teach the aforementioned feature and cites Bishop to cure this deficiency; however, Bishop is entirely non-analogous art. The MPEP § 2141.01(a)(i) states that to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. Bishop is directed to “real-time high-speed inspection of objects involving storing digital signal mask information of optical scans of objects at different magnifications[.]” See Abstract. Applicant fails to see how Bishop can be considered analogous art.

CONCLUSION

In view of the above, at least independent claims 1 and 16 and 31 are patentably distinct from the cited references and therefore are in condition for allowance. For at least this reason, Applicant respectfully submits that the rejections of claims 1, 16, and 31 under 35 U.S.C. 103(a) over Parker and Kaplan, as well as the claims which depend therefrom should be withdrawn.

Respectfully submitted,



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Date: _____

9/7/10